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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,719	01/18/2001	Hiroshi Inoue	35.C15061	5427

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/761,719	Applicant(s) INOUE ET AL.	
	Examiner Mary Cheung	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-14,16-23,26-34,36-49 and 60-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-14,16-23,26-34,36-49 and 60-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/29/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to the RCE filed on August 26, 2005. Claims 1-2, 6-14, 16-23, 26-34, 36-49 and 60-62 are pending. Claims 1-2, 13-14, 22-23, 33-34, 42, 44, 46, 48 and 60-62 are amended. Claims 3-5, 15, 24-25, 35 and 50-59 are canceled. All pending claims are examined.

Response to Arguments

2. Applicant's arguments filed July 29, 2005 have been fully considered but they are not persuasive.

In response to the applicant's argument that Ginter (U. S. Patent 5,892,900) fails to teach a roaming server receives change request information from a client and changes the intellectual property right protection system of digital content based on the change request information from the client, examiner respectfully disagrees. Ginter teaches a distributor modified content rights according to client's request, in which the distributor corresponds to the applicant's roaming server (column 293 lines 60-67).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-2, 6, 13-14, 22-23, 26, 33-34, 42-49 and 60-62 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al., U. S. Patent 5,892,900.

As to claims 1, 22, 42, 46 and 60-61, Ginter teaches a digital contents distribution system and method having a client, a digital contents server, a roaming server, and a network connected between the client, the digital contents server, and the roaming server (column 53 line 39 – column 54 line 32 and column 55 lines 6-29 and Figs. 1, 2, 78-80),

- a) wherein said roaming server comprises means for receiving from the digital contents server a digital content protected by a first intellectual property right protection system (column 56 lines 6-18 and column 326 line 49 – column 327 line 9 and Figs. 1, 2, 78-80; *specifically, “a first intellectual property right protection system” corresponds to “C_A” in Ginter’s teaching*);
- b) means for receiving change request information of the intellectual property right protection system from said client (column 293 lines 50-67);
- c) means for changing the intellectual property right protection system of the received digital content from the first intellectual property right protection system to a second intellectual property right protection system based on the change request information (column 293 lines 50-67); and
- d) means for transmitting the digital content protected by the second intellectual property right protection system to said client (column 293 lines 50-67).

As to claims 13, 33, 44, 48 and 62, Ginter teaches a digital contents distribution system and method having a client, a roaming server, and a network connected

between the client and the roaming server (column 53 line 39 – column 54 line 32 and column 55 lines 6-29 and Figs. 1, 2, 79-80),

- a) wherein said roaming server comprises means for receiving from said client a digital content protected by a first intellectual property right protection system (column 311 line 30 – column 312 line 32 and column 326 line 49 – column 327 line 9 and Figs. 1, 2, 78-80; *specifically, “a first intellectual property right protection system” corresponds to “C_A” in Ginter’s teaching*),
- b) means for receiving change request information of the intellectual property right protection system from said client (column 293 lines 50-67);
- c) means for changing the intellectual property right protection system of the received digital content from the first intellectual property right protection system to a second intellectual property right protection system based on the change request information (column 293 lines 50-67),
- d) means for transmitting the digital content protected by the second intellectual property right protection system to said client (column 293 lines 50-67).

As to claims 2, 14, 23 and 34, Ginter the change request information indicates a request for changing to the intellectual property right protection system corresponding to said client (column 293 lines 50-67).

As to claims 6 and 26, Ginter teaches said roaming server includes means for vicariously executing authentication between said client and said digital contents server (column 12 lines 31-38 and column 310 line 5 – column 311 line 29 and column 315 lines 42-58).

As to claims 43, 45, 47 and 49, Ginter teaches a storage medium storing program codes for execution the digital contents distribution methods of claims 42, 44, 46 and 48 (Fig. 5B and see claims 42, 44, 46 and 48 above).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-10, 16-19, 27-30 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of Lewis et al., U. S. Patent 6,725,372.

As to claims 7, 16, 27 and 36, Ginter teaches the digital content comprises digital data encoded in accordance with MPEG (column 250 line 59 – column 251 line 6 and column 326 lines 40-45). Ginter does not specifically teach the digital data encoded in accordance with MPEG-4. However, Lewis teaches encoding digital data in accordance with MPEG-4 (column 6 lines 15-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the digital data in Ginter's teaching to be encoded in accordance with MPEG-4 as taught by Lewis for allowing the digital contents server dealing with various standards of MPEG for attracting more clients.

As to claims 8, 17, 28 and 37, Ginter teaches the intellectual property right protection system comprises an IPMP System (column 57 lines 45-55; *specifically, the "IPMP system" corresponds to the "rules and controls" in Ginter's teaching*).

As to claims 9-10, 18-19, 29-30 and 38-39, Ginter does not specifically teach wherein IPMP_Type in IPMP_Descriptor IPMP Message prescribed in ISO/IEC SC29 14496-1 IS:1998 is used to identify the IPMP system. However, this standard is widely used; thus, one of ordinary skill in the art would have been motivated to use this standard for the system for better compliance during the system operation.

7. Claims 11-12, 20-21, 31-32 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of Lewis et al., U. S. Patent 6,725,372, and in further view of Fields et al., U. S. Patent 6,704,797.

As to claims 11-12, 20-21, 31-32 and 40-41, Ginter modified by Lewis teaches digital contents distributing system as discussed above. Ginter modified by Lewis does not specifically teach said client including means for transmitting IP_address (Internet Protocol address) information for identification of said client or said apparatus and transmitting URL (Uniform Resource Locator) information for identification of the digital content. However, Fields teaches these matters (abstract and column 4 lines 15-33 and column 6 line 58 – column 7 line 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teaching of Ginter modified by Lewis to include the feature of transmitting IP_address information for identification of said client and transmitting URL information for identification of the digital content as taught by Fields for preventing unauthorized access of the digital content.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300	(Official Communications; including After Final Communications labeled "BOX AF")
(571) 273-6705	(Draft Communications)

Mary Cheung
Primary Examiner
Art Unit 3621
November 8, 2005



MARY D. CHEUNG
PRIMARY EXAMINER